

REMARKS

Currently, claims 1-59 are pending in the present application. By this paper, Applicants submit the enclosed Rule 131 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger and the associated Exhibits A and B pursuant to 37 C.F.R. § 1.131 to swear behind Sikat et al. (US 2001/0031453A1). Applicants also submit the enclosed Rule 132 Declarations of Gary Landrum, Chris Felcman, and David Eichberger and associated Exhibits 1, 2, and 3 pursuant to 37 C.F.R. § 1.132 as evidence of non-obviousness. Furthermore, Applicants submit notice of recordation documents for Varghese et al. (US 2001/0037985A1) and for present application as evidence of common assignment to Compaq Information Technologies Group, L.P., successor in interest to Compaq Computer Corporation, pursuant to M.P.E.P. § 706.02(l) and 35 U.S.C. §§ 102(e)/103(c). A true and correct copy of the notice of recordation documents from Varghese et al. and the present application are enclosed herewith as Exhibits I and II. In view of the foregoing evidence and the following remarks, Applicants respectfully submit that the pending claims are patentably distinct from the prior art and in condition for allowance.

Rejections Under 35 U.S.C. §102

In the Final Office Action of the parent application, the Examiner rejected claims 41-44 under 35 U.S.C. §102(b) as anticipated by Foster et al. (US 5,594,617). Applicants respectfully assert that the pending claims are patentable over the cited reference in view of the following legal precedent and the following remarks.

***Legal Precedent***

First, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails

to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, Applicants remind the Examiner that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Third, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See*

M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

**Rejection of Claims 41-44 in view of Foster et al.**

***Omitted Features***

Applicants respectfully assert that the cited reference does not disclose all of the recited features of the rejected claims. For example, amended claim 41 recites, *inter alia*, “rotatably coupling the display and keyboard to form a *rack mountable assembly* having a 1U or thinner thickness in a closed configuration.” (Emphasis Added). Applicants respectfully stress that the Examiner’s proposed scope for the terms 1U and a rack mountable assembly is completely unreasonable and inconsistent with the scope of the specification and the understanding of one of ordinary skill in the art. See M.P.E.P. §§ 608.01(o) and 2111. One of ordinary skill in the art would not interpret references to “1U” and “rack mountable” to encompass an ordinary laptop computer, or anything unrelated to a rack structure, as disclosed by the Foster et al. reference. See Foster et al., column 3, lines 16-18. The Foster et al. reference is absolutely devoid of any teaching or suggestion of “1U” or a capability for *rack mounting*. In fact, the *portability or mobility* of Foster et al. is antithetical to the *rack mountability* recited in the instant claim. In view of the omitted features of “1U” and “rack mountable,” *inter alia*, the Foster et al. reference cannot anticipate claim 41.

***Omitted Features are NOT Inherent***

The Examiner argued that the Foster et al. reference discloses, “a structure ... *inherently capable of being mounted* in a 1U thick rack space.” See Parent Application, Paper 11, page 2 (Emphasis Added). Applicants respectfully assert that the cited reference *does not* inherently disclose features as the Examiner contends. Additionally, the Examiner repeatedly asserted that functional language, such as “rack mountable,” is insufficient to distinguish over

the prior art. *See* Parent Application, Paper 11, page 8 (quoting Examiner's Response to Arguments: "'rack mountable' is irrelevant since there is no structure in the claim that is not in the reference.>"). Applicants respectfully emphasize that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner "must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

In the instant case, Applicants respectfully assert that the Examiner's conclusory statement relating to the cited reference's inherent functionality or capability of "being mounted in a 1U thick rack space" provides neither evidence nor a cogent line of reasoning to support his position of inherency. As mentioned above, the *portable* nature of the cited reference is antithetical to the *mountable* configuration recited in the instant claim. *See* Foster et al., column 3, lines 18-19. The Examiner apparently believes that portable laptop computer of Foster et al. *may* be rack mountable, but this argument is based on mere possibilities. *It does not necessarily flow* from the teachings of Foster et al. that the portable laptop computer could be rack mountable, much less, *rack mountable in a 1U thick rack space*. The mere fact that such a feature is *possible* is not sufficient to support the Examiner's conclusion that the feature is *inherent*.

As such, Applicants respectfully assert that independent claim 41 and its respective dependent claims 42-44 are patentable over the cited reference. For these reason, Applicants respectfully request allowance of the foregoing claims.

#### **Rejection of Claims 56-57 in view of Sikat et al.**

In the Office Action, the Examiner also rejected claims 56-57 under 35 U.S.C. §102(e) as being anticipated by Sikat el al. (US Patent Application 2001/0031453). Applicants respectfully traverse this rejection.

***Removal of Sikat et al. and Mammoser et al. Pursuant to 37 C.F.R. § 1.131***

In view of the earlier date of the invention of the subject matter disclosed and claimed in the present application, Applicants have chosen to remove Sikat et al. (US 2001/0031453 A1) and Mammoser et al. (U.S. Patent No. 6,442,030) pursuant to 37 C.F.R. § 1.131. Applicants note that the Mammoser et al. reference is disclosed in an Information Disclosure Statement and PTO-1449 accompanying this paper. Under Rule 131, the Applicants may overcome a prior art rejection by filing an appropriate declaration that establishes invention of the claimed subject matter by the Applicants prior to the effective date of the reference(s) relied upon in the rejection. Prior invention may be shown either by proving actual reduction to practice prior to the effective date of the reference(s) or by proving conception of the invention prior to the effective date of the reference(s) coupled with reasonable diligence from prior to the effective date of the reference(s) to the filing date of the application.

Accordingly, Applicants submit the enclosed Rule 131 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger pursuant to Rule 131, signed by the inventors of record, to demonstrate that the invention disclosed and claimed in the present application was conceived and actually reduced to practice prior to the effective date of Sikat et al. and, also, prior to the effective date of Mammoser et al. Specifically, in paragraph 3 of the attached Rule 131 Declarations, the applicants/inventors declare that the subject matter disclosed and claimed in the above-referenced application was conceived at least as early as August 19, 1999. Applicants further submit that Exhibit A in its entirety, along with the corresponding Rule 131 Declarations, is sufficient to demonstrate conception of the claimed subject matter at least as early as August 19, 1999.

The effective date of Sikat et al. is December 18, 2000, while the effective date of Mammoser et al. is April 26, 2001. As indicated by paragraph 4 of the attached Rule 131 Declarations, the applicant/inventors declare that the invention disclosed and claimed in the present application was actually reduced to practice no later than August 28, 2000. Applicants further submit that Exhibit B in its entirety, along with the corresponding Rule 131

Declarations, is sufficient to demonstrate actual reduction to practice of the claimed subject matter no later than August 28, 2000.

In view of the evidence discussed above, Applicants respectfully request the Examiner remove Sikat et al. from consideration and allow pending claims 56-57.

### **Rejections Under 35 U.S.C. § 103**

In the Final Office Action of the parent application, the Examiner presented a multitude of references in various permutations and combinations to reject the instant claims. Under 35 U.S.C. §103(a), the Examiner rejected claims 1-5, 8-14, 15-21, 33-37, 47 and 50 as unpatentable over Harwell (US 6,142,590) in view of Foster et al.; claims 6, 7, 51, 52, 22, 53, 38-40, 48 and 49 as unpatentable over Harwell in view of Foster et al. and in further view of Sikat et al.; claims 23-25, 28-32, and 58 as unpatentable over Harwell in view of Foster et al. and in further view of Varghese et al. (US 2001/0037985A1); claims 26, 27, 54, 55 and 59 as unpatentable over Harwell in view of Foster et al., Varghese et al., and Sikat et al.; claim 45 as unpatentable over Foster et al. in view of Sikat et al.; and claim 46 as unpatentable over Foster et al. in view of Harwell. Applicants respectfully traverse these rejections for a number of reasons.

### ***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the references taught or suggested *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the

hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

***Removal of Sikat et al. Pursuant to 37 C.F.R. § 1.131***

Again, as discussed above, Applicants have chosen to remove Sikat et al. and Mammoser et al. pursuant to 37 C.F.R. § 1.131 in view of the earlier date of the conception and actual reduction to practice of the subject matter disclosed and claimed in the present application. Accordingly, all rejections based on Sikat et al. (or potential rejections based on Mammoser et al.) must be withdrawn.

***Removal of Varghese et al. under 103(c)/102(e)***

Regarding the Varghese et al. reference, the Applicants respectfully stress that Varghese et al. (US 2001/0037985A1) should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Varghese et al. (US 2001/0037985A1) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Compaq Information Technologies Group, L.P. As evidence of this common assignment, Applicants submit a copy of the notice of recordation documents from both the Varghese et al. reference and the present application. Although the cover of the Varghese et al. publication does not accurately display this assignment data, the notice of recordation of Varghese et al. clearly indicates the recorded Assignee as Compaq Computer Corporation, predecessor in interest of Compaq Information Technologies Group, L.P. *See* Exhibit I. Similarly, the notice of recordation of the present application clearly indicates the recorded Assignee as Compaq Information Technologies Group, L.P., successor in interest of Compaq Computer Corporation. *See* Exhibit II. In view of this evidence, the Applicants respectfully request the Examiner remove Varghese et al. (US 2001/0037985A1) from consideration. After Varghese et al. (US 2001/0037985A1) is

removed according to 35 U.S.C. § 103(c), all rejections based on Varghese et al. (US 2001/0037985A1) must be withdrawn.

#### **Harwell-Foster et al. Reference Combination**

After removing the Sikat et al. and Varghese et al. references, the only remaining rejections under Section 103 pertain to the Harwell-Foster et al. combination. In the Final Office Action of the parent application, the Examiner rejected claims 1-5, 8-14, 15-21, 33-37, 47 and 50 under 35 U.S.C. §103(a) as unpatentable over Harwell (US 6,142,590) in view of Foster et al., and claim 46 as unpatentable over Foster et al. in view of Harwell.

The cited reference combination fails to render obvious the instant claims for at least three reasons. First, the cited reference combination fails to disclose all of the features recited in the instant claims. Second, the cited reference combination lacks the necessary suggestion or motivation to combine. Third, the Applicants submit evidence of non-obviousness with regard to the subject matter disclosed and claimed in the present application.

#### ***Omitted Features***

In a general sense, each of the claims rejected under the instant Foster et al.-Harwell reference combination recite some semblance of a user interaction assembly mountable in a 1U thick rack space. As discussed in detail above, Applicants reiterate that, during patent examination, the pending claims must be given a reasonable interpretation consistent with the specification. See M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See M.P.E.P. § 2111. Regarding the recitation of “1U,” a “rack,” “rack mountable,” and other correlations to a rack structure, the Examiner must interpret the claims in a reasonable manner.

Turning to the claims, the independent claims 1, 15, 33, and 47 rejected under this reference combination recite the following features:

Claim 1: “a user interaction assembly mountable in a 1U thick rack space of the rack mount.”



Claim 15: “a user interaction assembly having a clamshell configuration mountable in a 1U rack space.”

Claim 33: “disposing a keyboard and display in a 1U rack space.”

Claim 47: “slidably removing a keyboard and display from a 1U thick rack space.”

The Examiner concedes that the Harwell reference merely discloses a 2U thick rack space and a user interaction device rested therein. *See* Parent Application, Paper 11, page 3. As such, the Examiner concedes the Harwell reference fails to disclose any semblance of a 1U thick user interaction device or a device capable of being configured for a 1U thick rack space. *See id.* The Examiner attempts to satisfy this deficiency with the Foster et al. reference.

First, Applicants respectfully assert that the Examiner has attributed qualities to the Foster et al. reference that are not disclosed therein. Specifically, the Examiner contends that the notebook computer of Foster et al. is “*inherently capable* of being mounted in a 1U thick rack space.” *See* Parent Application, Paper 11, page 4.

The Foster et al reference discloses a *notebook or portable* computer. As is commonly known, the primary purpose of a notebook computer is to allow for *mobile* computing and ease in transportation during such computing. This is antithetical to the user interaction systems configured for *rack mounting* as recited in the instant claims. There is no reason to believe the notebook computer of the Foster et al. reference is “capable of being mounted in a 1U thick rack space,” as the Examiner contends. As argued above, the mere fact that the art of the Foster et al. reference *may* be mounted as the Examiner contends is not sufficient evidence to support the conclusion that the Foster et al. notebook *inherently or necessarily* is so mountable. Portable or notebooks computers have a variety of configurations that are contrastingly different from the stationary racks of the instant claims. To assume inherent compatibility between the two would be reading elements into the Foster et al. reference teachings that not disclosed therein. In other words, the burden is on the

Examiner to show that the cited art must *necessarily* disclose what is recited in the instant claim.

Second, the Examiner contends that, the recitation “mountable in a 1U thick rack space” is merely functional. *See* Parent Application, Paper 11, page 8. Applicants respectfully stress that the functional-structural recitation, “mountable in a 1U thick rack space” must be evaluated for what it reasonably conveys to one of ordinary skill in the art. *See In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997); *see also In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); M.P.E.P. § 2173.05(g).

In the instant claim, the recitation serves to define structural attributes of interrelated component parts of the claimed assembly in a clear and complete manner. Specifically, the foregoing recitations clearly define the structure of the claimed system based on 1U and rack mounting. As argued above, the mere fact that the laptop of Foster et al. *may*, in a given orientation, have a thickness less than 1U is not sufficient evidence to assume that the laptop is, in fact, mountable in a rack. For example, the Foster et al. reference discloses a laptop which, in its thinnest position, prevents access to the peripheral connectors 42. *See* Foster et al., column 4, lines 30-36. In this thin position, the moveable battery blocks access to the connectors. *See id.* Although the prior art *may* “fit” inside of a 1U space in a rack, such lack of access suggests that the prior art is not capable of being *mounted* in the same 1U sized rack. By interpreting the cited reference as the Examiner contends, the Examiner has effectively ignored the 1U rack mountable feature of the instant claims. Accordingly, the Examiner’s argument that the above recitation is, “merely functional,” is an insufficient reason to ignore the limitation. *See id.*

In view of these omitted features, Applicants respectfully assert that independent claims 1, 15, 23, and 47 and their respective dependent claims are patentable over the cited reference combination. Accordingly, Applicants respectfully request allowance of the pending claims.

***Lack of Motivation or Suggestion to Combine***

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Harwell and Foster et al. references to reach the presently claimed technique. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

In the rejection, the Examiner combined the Harwell and Foster et al. references based on the *conclusory and subjective statement* that it would have been obvious to combine rack system of Harwell with the less than 1U thick computer of Foster et al. “for *increased storage capabilities* due to the decreased thickness and ease in assembly, since the less than 1U thick computer would fit in a 1U thick space.” See Parent Application, Paper 11, page 4. However, the Examiner has not provided any objective evidence to support this alleged reason to combine the cited references. As argued above, the Foster et al. reference relates to *portable* notebook computers, which are primarily concerned with *ease of transportation*. In contrast, rack systems are highly concerned with storage capabilities, redundancies, security, and so forth. At least in terms of storage capabilities, if not more, a portable computer is clearly not suitable for the requirements of rack systems. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references.

Applicants further emphasize that it is improper to use hindsight reconstruction in formulating a rejection under Section 103. See *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I 1985); see also *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. See *id.* Applicants respectfully assert

the Examiner, at best, employed the teachings of the instant application to establish the motivation necessary to combine the two references. As such, Applicants respectfully assert the Examiner has employed impermissible hindsight reconstruction.

In view of the missing objective evidence of the necessary motivation or suggestion to combine the references, independent claims 1, 15, 23, and 47 and their respective dependent claims are believed to be patentable over the cited reference combination. Accordingly, Applicants respectfully request allowance of the pending claims.

***Evidence of Non-Obviousness Pursuant to 37 C.F.R. § 1.132***

Applicants further submit evidence of non-obviousness pursuant to 37 C.F.R. § 1.132. Specifically, as discussed in further detail below, the Applicants submit Rule 132 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger and objective evidence of commercial success to rebut the Examiner's previous rejections under Section 103.

Obviousness is a conclusion of law based on a number of underlying factual inquiries. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1572 (Fed. Cir. 1988). The Supreme Court has stated that three factual determinations are required in an analysis under Section 103: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). In addition, the Examiner must consider all secondary considerations bearing on obviousness, such as commercial success, "industry acquiescence," long felt but unsolved needs, and failure of others, must also be considered. *Id.* at 17-18; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983); *see also* M.P.E.P. § 716.01(a). Moreover, the Examiner must consider all of the competent rebuttal evidence taken as a whole, including arguments and secondary considerations, against evidence of a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *see also* M.P.E.P. § 716.01(d). Regarding the secondary considerations of non-obviousness, a "nexus" is required between the merits of the claimed invention and the evidence of secondary considerations. *See Ashland Oil, Inc. v.*

*Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 (Fed. Cir. 1985); *see also* M.P.E.P. § 716.01(b). In addition, to be of probative value, the secondary considerations must be factually supported by an appropriate affidavit or declaration and objective evidence. *See In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *In re Lindner*, 457 F.2d 506, 508 (C.C.P.A. 1972); *see also* M.P.E.P. § 716.01(c). Regarding evidence of commercial success, commercial success abroad, as well as in the United States, is relevant in resolving the issue of non-obviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984); *see also* M.P.E.P. § 716.03.

In view of the commercial success of the subject matter disclosed and claimed in the present application, Applicants have chosen to rebut the Examiner's obviousness rejections based on evidence of non-obviousness pursuant to 37 C.F.R. § 1.132. Accordingly, Applicants submit the enclosed Rule 132 Declarations of inventors Gary Landrum, Chris Felcman, and David Eichberger, signed and dated by the inventors of record, to demonstrate that the invention disclosed and claimed in the present application has achieved significant commercial success attributed to the features set forth in the pending claims.

Specifically, in paragraphs 3 and 4 of the attached Rule 132 Declarations, the applicants/inventors declare to have been involved in the development of a product named Ruger, which comprises a 1U rack mountable display and input device, e.g., a trackball and/or keyboard, as set forth in the claims and as illustrated in Exhibit 1. In paragraph 5 of the attached Rule 132 Declarations, the applicant/inventors further declare that the Ruger product has a clamshell configuration in which the display can be nested within the input device, e.g., the keyboard, as set forth in the claims and as illustrated in Exhibit 1. For these reasons, the Ruger product is commensurate in scope with the pending claims of the present application.

Turning to the sales data set forth in Exhibit 2, the applicants/inventors further declare, upon information and belief, that the Ruger product has been sold from the third fiscal quarter of 2001 through the present time. *See* Rule 132 Declarations, Paragraph 6. Furthermore, the applicants/inventors declare, upon information and belief, the sales of the Ruger product in the United States were tabulated for the third fiscal quarter of 2001 through the third fiscal quarter

of 2003. *See* Rule 132 Declarations, Paragraph 7; Exhibit 2. Regarding sales numbers, the applicants/inventors declare, upon information and belief, the quarterly sales of the Ruger product during the foregoing time period were as follows: 711, 2830, 2241, 2835, 4089, 4125, 3836, 4280, and 4327, as tabulated in exhibit 2. *See* Rule 132 Declarations, Paragraph 8; Exhibit 2 (highlighted in yellow). Upon information and belief, the applicant/inventors further declare that the Ruger product achieved a significant sales growth relative to all rack mountable keyboards, all rack mountable monitors, and all rack mountable keyboards and monitors of the Assignee. *See* Rule 132 Declarations, Paragraphs 9-11; Exhibit 2 (highlighted in orange, blue, and green). For example, relative to all rack mountable keyboards and monitors of the Assignee, the relative sales growth of the Ruger product increased from 5.1% to 53.7% between the third quarter of 2001 and the third quarter of 2003. *See* Rule 132 Declarations, Paragraph 11; Exhibit 2 (highlighted in green). For these reasons, Applicants believe the disclosed and claimed subject matter set forth in the present application has attained *significant commercial success* in the art of rack systems and, particularly, in the art of rack mount keyboards and monitors.

Turning to the *nexus* criteria, the Applicants submit evidence of customer feedback, which clearly indicates the foregoing commercial success is attributed to the disclosed and claimed features of the present application. Specifically, the applicants/inventors declare, upon information and belief, the Assignee provided the Ruger product to at least thirteen representative customers and tabulated the customer feedback in a spreadsheet set forth in Exhibit 3. *See* Rule 132 Declarations, Paragraphs 12 and 13; Exhibit 3. Regarding previous rackmount keyboards and displays, the applicants/inventors declare, upon information belief, the customers commented on a general dissatisfaction with the size of previous 2U configurations and, specifically, commented on the importance of size "to save rack space" and that "every 'U' is precious." *See* Rule 132 Declarations, Paragraph 14; Exhibit 3 (highlighted in yellow). Moreover, the applicants/inventors declare, upon information belief, the customers indicated an unsatisfied need for a 1U assembly. *See* Rule 132 Declarations, Paragraph 15; Exhibit 3 (highlighted in yellow). One customer specifically commented "from the beginning we were looking for 1U integrated keyboard from sizing point of view." *Id.* Finally, the applicants/inventors declare, upon information belief, the customers indicated appreciation and

praise of the Ruger product with reference to the Ruger's 1U size, space savings relative to existing 2U monitor and 1U keyboard/switch, form factor, and ability of the display screen to fold down rather than up (i.e., clamshell configuration). *See* Rule 132 Declarations, Paragraph 16; Exhibit 3 (highlighted in yellow). Clearly, this customer feedback indicates the importance placed on every "U" of rack space, the dissatisfaction with previous 2U configurations, and the excitement about the 1U and clamshell features of the Ruger product. *See* Rule 132 Declarations, Paragraphs 14-16; Exhibit 3 (highlighted in yellow). For these reasons, Applicants attribute the foregoing commercial success to the disclosed and claimed subject matter set forth in the present application. Therefore, the foregoing *commercial success has a strong nexus with the claimed invention.*

Turning to the cited references, Harwell teaches a rack mountable keyboard and monitor disposed end-to-end in a 2U rack space. *See* Harwell, Col. 2, lines 51-67. The Examiner turned to Foster et al. for its smaller dimensions, yet Foster et al. teach a *non-rack mount* laptop computer with no mention of 1U or any sort of rack mounting. *See* Foster et al., Col. 3, lines 18-29. In contrast, the present claims recite a display and input device mountable in a 1U rack space and, in certain claims, a clamshell configuration of the display and input device. As discussed above, the Applicants have attained *significant commercial success attributed to these claimed features*, which are not disclosed by either Harwell or Foster et al. Apparently, the Examiner believes that a laptop computer is an obvious solution to the space problems associated with rack systems, yet the foregoing commercial success and customer feedback clearly indicate the contrary.

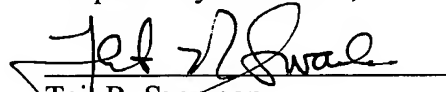
For these reasons, Applicants reiterate that the present claims are patentably distinct from the cited references, taken alone or in combination. Accordingly, Applicants request the Examiner withdraw all previous rejections and allow the pending claims.

**Conclusion**

The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: November 24, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tait R. Swanson', is written over a horizontal line.

Tait R. Swanson

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